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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,407	10/20/2003	Sam Johnson	01003.1010	2572
35856	7590	07/07/2006	EXAMINER	
SMITH FROHWEIN TEMPEL GREENLEE BLAHA, LLC			PANDYA, SUNIT	
P.O. BOX 88148			ART UNIT	
ATLANTA, GA 30356			PAPER NUMBER	

3714

DATE MAILED: 07/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/689,407	<b>Applicant(s)</b> JOHNSON, SAM	
	<b>Examiner</b> Sunit Pandya	<b>Art Unit</b> 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12/2/05.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 11-27 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Newly revived claims 11-27 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-10 are drawn to a system for providing closed loop operation of a gaming machine, classified in class 463, subclass 12.

II. Claims 11-20 are drawn to method of providing closed loop operation of a gaming machine, classified in class 463, subclass 16.

III. Claims 21-27 are drawn to a control box, classified in class 463, subclass 42.

Each noted inventions are distinct from each other because of the reason provided below.

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process can be used on a standalone machine (i.e., without the controller box).

Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the system of Group I need not have the controller box perform the function of

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interfacing the display unit. The subcombination has separate utility such as the main processor for a gaming system.

Inventions II and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process can be performed on a standalone system.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

3. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 11-27 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

4. The requirement is still deemed proper and is therefore made FINAL.

5. This application contains claims drawn to an invention nonelected with traverse. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Response to Arguments on Traverse***

The applicant argues that group I and II recites steps that have equivalent in the system claim elements, and should be examined unison. The examiner respectfully disagrees with the applicant. In this instant case group I discloses a process, which could be used on a standalone machine, which includes a control box to perform the stated process, whereas group II teaches an apparatus (i.e. control box).

The applicant argues the group I and III are both directed towards the controller box utilized within the system claims. The examiner respectfully disagrees with the applicant. The system in-group I does not need the control box to perform the function of interfacing the display unit. The subcombination has separate utility such as the main processor for a gaming system.

The applicant argues that group II recites steps that have equivalents in the system claims of group III. The applicant respectfully disagrees with the applicant. Group II discloses an apparatus (i.e. control box), wherein group III teaches the functions of the control box.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joshi (US Patent Number 6,843,723) in view of Brosnan et al. (US Patent Number 6,682,432).

**Claim 1:** Joshi teaches a system for providing closed-loop operation for promotional events for a video gaming machine (10). The promotional event is associated with particular winning criteria – i.e., as determined by the modified payout structure. (Col 2, 32-39) Joshi describes storing the visual element datasets in a memory device (20) that interfaces with the game machine processor. (Col 2, 40-42) This is combination of memory device and processor is a controller box that is operable to interface to the video gaming machine. There may be a promotional server (152) that is communicatively coupled to the controller box and operable to maintain a database of promotional events with each promotional event having promotional content (visual motif), winning criteria (modified payout structure) and scheduling information (a list of holidays, start and stop times). (See Summary of the Invention section.) As noted above, this information is loaded into the memory device. Thus the server (152) delivers to the controller box, at least a portion of the database of promotional events. The controller box displays promotional content on the display of the video gaming machine. Figures 12 & 13 show the display of Christmas promotional content. The controller box, which includes the CPU (16), monitors the activity of the video gaming machine to determine if the winning criteria have been met. The controller box provides information indicating that the winning criteria for a particular promotional event have been satisfied – by causing payout mechanism (22) to pay out winnings.

Joshi does not specifically disclose that the promotional server receives from the controller box, messages indicating that the winning criteria for a particular promotional event have been met. It is well known to send all information regarding winnings to a

server for casino accounting purposes. Brosnan teaches reporting winning conditions to an accounting server (71). This allows the casino to keep track of the money paid out – a matter of vital importance. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Joshi in view of Brosnan to have the server receive messages from the controller box indicating that the winning criteria for a particular promotional event have been met in order to allow the casino to keep track of money paid out.

**Claim 2:** The promotional server includes a software program that enables a user to define particular promotional events by defining an award to be associated with the promotional event (i.e., designating the modified payout structure); defining a schedule for the promotional event; defining the winning criteria for the promotional event; receiving instructions to store the defined promotional event; and storing the defined promotional event into the database. (See Summary of the Invention.)

**Claim 3:** The software program further comprises an interface to upload graphical and textual content to be included in the promotional content. (Col 10, 14-18)

**Claim 4:** The software program must include an interface to create graphics and textual content to be included in the promotional content. The data must be created before it can be downloaded.

**Claim 5:** The controller box is associated a single video gaming machine that is associated to a single user and is operative to display the promotional content in accordance with the scheduling information. (Fig 18A)

**Claim 6:** The controller box is operative to receiving entertainment content (i.e., game motifs) from an entertainment source (152) and to display the entertainment content on the display of the video gaming machine.

**Claims 7-10:** Joshi teaches implementation on both video poker and video blackjack machines. (Col 15, 38) While the choice of which hands to make into winning criteria is a matter of design choice – any combination of cards could be considered a “winning hand”, Joshi teaches that the winning criteria may be the appearance of three symbols that are not included on the payout table. (Col 5, 57-60) Thus Joshi teaches winning combinations that are not in the payout table and teaches winning combinations that are a particular hand. (Figs 4A & B)

### ***Response to Arguments***

Applicant's arguments filed 10/31/05 have been fully considered but they are not persuasive.

The applicant argues that Joshi does not disclose all of the claimed limitation of claim 1. The examiner respectfully disagrees. The rejection above does teach of all the elements disclose within claim 1, since the prior art structure is capable of performing the same function cited in the claim, the cited reference meets the claim's limitation.

Specifically the applicant argues that Joshi does not disclose a control box, which displays promotional content on the gaming machine, monitors the activity of the video gaming machine to determine if the winning criteria has been met and provide information indicating the winning criteria for a particular promotional event has been satisfied. However Joshi clearly



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discloses a gaming machine capable of achieving all of the claimed elements, including a controller box that displays promotional content on the display of the video gaming machine. (Figures 12 & 13 show the display of Christmas promotional content.) The promotional event is associated with particular winning criteria – i.e., as determined by the modified payout structure. (Col 2, 32-39) Combination of Joshi and Brosnan teaches reporting winning conditions to an accounting server (71). Since the device disclosed by combination of Joshi and Brosnan discloses all of the limitation disclosed within claim 1, the rejection is maintained.

In response to applicant's argument that combination of Joshi and Brosnan is not a valid combination, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The combination teaches reporting winning conditions to an accounting server, wherein the server accumulates and awards the winner the winning amount, which also inherently allows the server to make sure that the winning criteria has been satisfied prior to awarding the winning to a player.

Consequently, for the reasons given above, the rejection is maintained.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunit Pandya whose telephone number is (571) 272-2823. The examiner can normally be reached on M - F: 7:30 am - 5 pm.

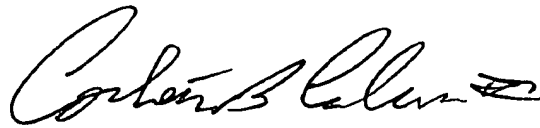
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert OLSZEWSKI can be reached on (571) 272-6788. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR

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system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SP

A handwritten signature in black ink, appearing to read "Corbett B. Coburn", with a stylized flourish at the end.

**CORBETT B. COBURN  
PRIMARY EXAMINER**